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ESMOND et al.

TECH CENTER 1600/2800 Appl. No. 09/394,712

29 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Support for new claim 25 may be found in claim 1 and cancelled claim 6.

The compound 5-[4-[2-(5-ethylpyridin-2-yl)ethoxy]benzyl]thiadiazolidine-2,4-dione (new claim 26) finds support in col. 15, lines 13-14 of U.S. Pat. 5,478,852 (the '852 patent) cited on page 7, lines 12, 16 and 19 of the present application. This patent is incorporated by reference into this application. See page 11, lines 24-25 of the present application. A copy of this patent was submitted together with the Supplemental Information Disclosure Statement filed April 13, 2000. The hydrochloride salt of this compound (new claim 27) finds support in col. 15, line 46, of the '853 patent.

The compound 5-[4-[2-[N-methyl-N-(2-pyridyl)amino]ethoxy]benzyl]thiadiazolidine-2,4-dione (new claim 28) finds support in col. 15, lines 27-28 of the '852 patent. The maleate salt of this compound (new claim 29) finds support in col. 15, line 58, of the '853 patent.

No new matter has been added by way of these amendments.

Based on the above amendment and the following remarks, Applicant(s) respectfully request(s) that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejection under 35 U.S.C. § 112

The Examiner has rejected claims 1-8 and 13-20 under 35 U.S.C. §112, first paragraph, because the specification, while enabling for treating Alzheimer's disease,

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allegedly does not enable the prevention of Alzheimer's disease. Applicants respectfully traverse this rejection.

Applicants respectfully disagree with the Examiner's contention that the prevention of Alzheimer's disease is not credible. However, solely in an effort to expedite the allowance of the present application, claims 1, 8 and 13 have been amended to remove reference to the prevention of Alzheimer's disease. Withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1 and 3 under 35 U.S.C. §102(b) as being anticipated by Maack *et al.* (WO 95/13823), Baker *et al.* (U.S. Pat. No. 5,534,615), Klein *et al.* (U.S. Pat. No. 6,025,157) or Rosenthal (U.S. Pat. No. 5,364,769). According to the Examiner, the cited references teach the use of insulin-like growth factor to treat Alzheimer's disease. Applicants respectfully traverse this rejection.

Without acquiescing to the propriety of this rejection, Applicants have cancelled claim 3 and added a proviso to claim 1 that the agent is not insulin-like growth factor. Withdrawal of the rejection is respectfully requested.

The Examiner has also rejected claims 1 and 4 under 35 U.S.C. §102(b) as being anticipated by Rosenthal or Dubach *et al.* (WO 96/03087). According to the Examiner, the cited references teach the use of a dopamine agonist to treat Alzheimer's disease. Applicants respectfully traverse this rejection.

Without acquiescing to the propriety of this rejection, Applicants have cancelled claim 4 and added a proviso to claim 1 that the agent is not a dopamine agonist. Withdrawal of the rejection is respectfully requested.

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The Examiner has also rejected claims 1 and 6-7 under 35 U.S.C. §102(e) as being anticipated by Grainger *et al.* (U.S. Pat. No. 6,117,911). According to the Examiner, Grainger *et al.* teach the use of thiazolidinediones to treat Alzheimer's disease. Applicants respectfully traverse this rejection.

Applicants note that the priority application of Grainger *et al.* was filed on April 11, 1997. In contrast, the present application claims priority to U.S. Provisional Appl. No. 60/039,607, filed March 12, 1997. The invention of claims 1 and 6-7 is fully supported in Applicants priority application. Therefore, Grainger *et al.* is not prior art under 35 U.S.C. §102(e) to the present application. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103

The Examiner has rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Rosenthal *et al.* or Dubach *et al.*, each in view of Michaelides (U.S. Pat. No. 5,597,832). According to the Examiner, it would have been obvious to one of ordinary skill in the art to substituted bromocryptine for a dopamine agonist in the primary references, as Michaelides *et al.* teach that bromocryptine is the most widely used direct-acting dopamine agonist. Applicants respectfully traverse this rejection.

Without acquiescing to the propriety of this rejection, Applicants have cancelled claim 4. Withdrawal of the rejection is respectfully requested.

Other Matters

On April 13, 2000, Applicants filed a Preliminary Amendment wherein claims 9-12 were cancelled, claims 1 and 13 were amended, and new claims 21-24 were added. However, the present Office Action indicates that claims 1-8 and 13-20 are pending, suggesting that only part of the amendment was entered. Applicants respectfully request that claims 21-24 be entered and claims 1 and 13 be amended before the present amendment is entered. Applicants request that the Examiner acknowledge that these amendments have been entered in the next communication from the office.


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Prompt and favorable consideration of this Amendment and Reply is respectfully
requested.

Respectfully submitted,



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: Nov. 22, 2000

312 Blair Court, N.W.
Vienna, VA 22180
(202) 371-2600

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